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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 04/09/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

48-5

Office Action Summary

Application No.

09/601,245

Applicant(s)

GERBER ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

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DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the abstract is not written in narrative form, it is written like claim language. Correction is required. See MPEP § 608.01(b).

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no

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text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. The disclosure is objected to because of the following informalities: the arrangement of the specification must conform to the arrangement and headings shown above. Also, the first sentence after the title must be a sentence in which the priority to related cases is claimed.

Appropriate correction is required.

Claim Objections

5. Claim 1 is objected to because of the following informalities: the phrase "characterized in that" on line 2 should be deleted because it does not add any limitation to the claim, and at the same time tends to render the claim confusing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation that the packaging material has a "hologram-like" image, but does not have a hologram was not described in the specification in a way that would enable one skilled in the art to make the

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packaging material. It is not understood what is considered a hologram-like image, but is not a hologram.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-14, the use of reference characters to the drawings in claim language is allowed but discouraged because the claims must be determinable to the scope of the invention claimed without reference to the drawings.

Additionally, only one reference number is allowed to designate a specific limitation of the invention.

Regarding claim 1, the limitation in the preamble that the packaging material has a "hologram-like image" renders the claim vague and indefinite because it is not understood what the scope of the definition of hologram-like is, additionally the negative limitation "with the proviso that holograms in the packaging materials are excluded" is contradictory to the limitation in

the preamble. Hologram-like image would only completely comprise a hologram in scope and yet in the same claim holograms are excluded from the scope of the claim. Clarification is required.

Additionally, in claim 1 the contradictory limitations of "embossed metal foil or metallized plastic film" in lines 4-5 and the limitation "embossed image on the metal foil of metallized plastic film" render the claim vague and indefinite because it is not understood if the packaging material comprises a metal foil or metallized plastic film alone or combined as one layer or combined as two separate layers. Clarification is required.

Claim 2 recites the limitation "functional layers" in line 3. There is insufficient antecedent basis for this limitation in the claim, because the claim recites the phrase "characterized in that", which entails a further description of a previous claim, but the functional layers were never described in the previous claim. It is suggested by the Examiner to change "characterized in that" to "further comprising" in order to provide sufficient antecedent basis for this limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting

claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as", or in this instance "in particular" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 3-6 recite the broad recitation metal foil, and the claim also recites aluminum foil, which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where

broad language is followed by "such as", or in this instance "in particular", and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 4-6 recite the broad recitation polyolefin, and the claim also recites polyethylene, which is the narrower statement of the range/limitation.

Claims 5-7 recites the limitation "functional layer". There is insufficient antecedent basis for this limitation in the claim, because the claim recites the phrase "characterized in that", which entails a further description of a previous claim, but the functional layers were never described in the previous claim.

Regarding claim 9, the limitation "preferably" for tubes renders the claim vague and indefinite because it is not understood if the tube is the only embodiment claimed or if it is just one of the many shapes or articles that comprise a packaging material according to claim 1. Additionally, the

limitation "containing or comprising" is confusing because it is not understood what the difference in the two limitations are and how the packaging material can be either comprised or contained in the articles listed. For examining purposes "containing" is taken as open language like "comprising".

Regarding claims 8 and 11-14, the limitation that the polyolefin of the multi-layered plastic layer "features" a printed image on one or both sides renders the claim vague and indefinite because it is not understood how a layer "features" an image, or if limitation is referring to a process limitation. The examiner suggests changing the "characterized in that" language to "further comprising a printed image on one or both sides of the polyolefin layer of the multi-layered plastic layer".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-3, 5, and 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Boswell (USPN 5,643,678).

Boswell anticipates a foil/composite sheet with a diffraction grating image, which is not a hologram (see abstract). The limitation that the foil must be a "covering" or "wrapping" foil in claim 9 is an intended use of the foil, and therefore is given little patentable weight. The sheet comprises a plastic carrier made up of polyethylene in a thickness of 12-50 micrometers (col.4, 1.17-23). On the inner side of the plastic carrier are two lacquer coatings each with a thickness of 0.5-5 micrometers, which is similar to 3-80 g/m² (col.4, 1.31-34). On the inner side of the lacquer layers is a metal layer made up of aluminum with a thickness of 20-100 nanometers and embossment receiving coating with a thickness of 0.025-1 micrometer (col.46-57). The image is embossed onto the receiving coating, metal layer and soft lacquer layer, which make up an embossed metallized plastic film (col.5, 1.36-40). The composite sheet is adhered to a film comprising polyethylene or polypropylene (col.9, 28-40), by an adhesive coating that is picked for its adherence to the polyethylene or polypropylene. Primary printing information facing upward if it is desired to have the security hologram affixed to the primary viewing surface, therefore the polyethylene layer of the multi-layered

plastic has a printed image on one side of the layer (col.9, 1.33-40). Note, the recitation that the composite sheet defined in the claims is a packaging material with hologram-like image has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 6-7 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boswell (USPN 5,643,678) in view of Sander (USPN 4,629,647).

Boswell teaches all that is claimed in claim 1 and further comprising a functional layer comprising polyethylene (col.9, 1.28-33) and an adhesive chosen to adhere to the polyethylene (col.6, 1.6-13). The multi-layered plastic film comprises a lacquer coating and a film containing polyethylene, as described above in the thickness values described above. Boswell fails to explicitly teach the adhesive layer for the functional layer comprising lacquer and the specific thickness values of the individual layers. However, it is notoriously well known in the art that a lacquer coating is an adhesive that bonds polyethylene to a metal substrate, as taught by Sander in columns 6-7, and Boswell teaches that the adhesive is chosen depending on the adherence to the functional layer, which in this case is polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to use a

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lacquer as the adhesive bonding the composite sheet to the functional layer, because of its known adherence and protective properties, taught by Sander, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, absent the showing of unexpected result. *In re Leshin*, 125 USPQ 416. Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the ranges for the thickness values of the individual layers of the film, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, absent the showing of unexpected result. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boswell (USPN 5,643,678) in view of Curiel (USPN 6,164,548).

Boswell teaches all that is claimed in claim 1 and that the multi-layered plastic film comprises polyethylene, but fails to explicitly teach that the multi-layered plastic film further comprises a melt extrudate of polyethylene in order to bond the

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polyethylene to the metal foil. However, Curiel teaches that when forming a tamper-resistant article comprising a metal core and resinous plastic material composed of polyethylene bonded to it, then the polyethylene is extruded onto the metal core (see abstract). One of ordinary skill in the art would have recognized that when polyethylene is extruded onto a surface a melt extrudate of polyethylene is going to be formed between the resin and the substrate. The polyethylene is extruded onto the metal core, because extrusion provides a preferred bond between the metal and polyethylene (col.2, 1.53-59), as taught by Curiel.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to bond the polyethylene and metal core by extrusion, which would obviously have a layer of melt extrudate of polyethylene between the polyethylene and metal core rather than adhering using lacquer, because extrusion provides a strong bond between the metal and polyethylene, as taught by Curiel.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boswell (USPN

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5,810,957); Weitzen et al (USPN 4,725,111); Sander (USPN 4,629,647).

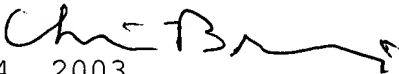
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB
April 4, 2003




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/7/03